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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/020,401	12/18/2001	Tomas Back	21547/0287	9654

30678 7590 12/13/2004

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EXAMINER

BUMGARNER, MELBA N

ART UNIT PAPER NUMBER

3732

DATE MAILED: 12/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/020,401	BACK ET AL.	
	Examiner	Art Unit	
	Melba Bumgarner	3732	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 September 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 11-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☒ Certified copies of the priority documents have been received in Application No. 09/423,090.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. Claims 11-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is unclear whether the implant is intended to be positively claimed, in that in claim 1 it is connected to the element through recitation of "center axes of each of the seats connecting with center axes of the implants."

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 11-15 are rejected as understood, under 35 U.S.C. 102(b) as being anticipated by Emmanuel. Emmanuel discloses an elongate support element 48 comprising plural seats (page 10 line 25) penetrating a surface on the element, the element comprises a homogeneous material (page 12 line 34), a wall of each seat comprises the material, and figure 4 shown no communication between the surface on the elongate support element and an opposing surface of the element. Patentable weight is not given to inferentially claimed components. As to claim 12, each wall has a surface in the material. The process and the intermediate products used in the process by which the element is made are not given patentable weight, because a product claim

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is properly met if the final product is shown regardless of the process used. As to claims 13-15, the material at the wall possesses the same material in the element having same material strength, does not have intermediate layers of material compositions and material alterations, and the same chemical composition in that the whole element is made of the same material. Emmanuel does not show material alterations other than shaping (machining) of the material.

4. Claims 11-19 are rejected, as understood, under 35 U.S.C. 102(e) as being anticipated by Willoughby (5,873,721). Willoughby discloses an elongate support element comprising plural seats a surface on the element, the element comprises a homogeneous material, a wall of each seat comprises the material, and no communication between the surface on the elongate support element and an opposing surface of the element (figure 36, column 79 line 17). As to claim 12, each wall has a surface in the material. The process and the intermediate products used in the process by which the element is made are not given patentable weight, because a product claim is properly met if the final product is shown regardless of the process used. As to claims 13-15, the material at the wall possesses the same material in the element having same material strength, does not have intermediate layers of material compositions and material alterations, and the same chemical composition in that the whole element is made of the same material. Willoughby does not show material alterations other than shaping (machining) of the material. Willoughby discloses a method for producing and installing a tooth replacement structure comprising forming at least one recess directly in a blank material using milling equipment to form a support part from the blank material, the forming at least one recess avoids forming a through hole in the material, applying the support part to implants using the recess as a seat in the support part, the seat meets set accuracy of fit, and applying tooth replacement material to the support part

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(column 79 line 25). As to claims 17 and 18, the seat is in the formed element using milling equipment, which is fed milling coordinates information and integrated milling data. As to claim 19, the recess avoids material not integral with the blank material.

Response to Arguments

5. Applicant's arguments filed September 24, 2004 have been fully considered but they are not persuasive. The prior art shows the limitations as claimed. The surface on the elongate support element and an opposing surface on the elongate support element do not communicate as they are on opposite sides of the element as seen in figure 4. Applicant's arguments with respect to claims 16-19 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Sillard (5,503,557) is cited to show the state of the art with respect to dental prosthesis element.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melba Bumgarner whose telephone number is 571-272-4709. The examiner can normally be reached on Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Shaver can be reached at 571-272-4720. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in cursive script, reading "Melba Bumgarner".

Melba Bumgarner
Patent Examiner